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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,714	04/06/2001	Bruce Ross	56970	5603
7590	07/14/2006		EXAMINER	
DENNIS H. LAMBERT DENNIS H. LAMBERT & ASSOC. 7000 VIEW PARK DRIVE BURKE, VA 22015			SHIFERAW, ELENI A	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/828,714	ROSS, BRUCE	
Examiner	Art Unit		
Eleni A. Shiferaw	2136		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 April 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Detailed Action***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/24/2006 has been entered.

Response to Amendment

2. Applicant's arguments/amendments with respect to amended claims 1, 5, 10, 16, and 18, added claims 19-21, and presently pending claims 1-21, filed on 04/24/2006 have been fully considered but are not persuasive.

Response to Arguments

3. Applicant argues that:
 - a. Kawan fails to disclose "*data file structure that functions to interact with a point-of-sale system regardless of the structure of the upper level interface and middleware or API*, Remark page 8" as recited on claim 1.
 - b. The Griswold invention is intended for an entirely different purpose than the present invention and no motivation to combine the teachings of Griswold within the system of Kawan.

c. Deo does not have any *means* “... to control access and communication between the reading and writing device or terminal and the fixed data structure on the card regardless of the structure of an upper level user interface, Remark page 9 par. 4, page 12 par. 2, ” as recited on claims 16 and 5.

However, Examiner disagrees with applicant.

Regarding argument (a), Argument is not persuasive. Applicant **again** amends the preamble of claim 1 and argues the reference is not teaching. The argued subject matter, (a), is not claimed for independent claim 1 and dependent claims 2-4.

However the amended subject matter on the preamble has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Dependent claims 2-4 are also rejected at least by virtue of their dependency on independent claim 1 and by other reason set forth in this office action dated 7/5/06.

Regarding argument (b), Argument is not persuasive. Griswold smart token is a smart card in the form of a coin-shape (col. 2 lines 43-45 and col. 3 lines 66-col. 4 lines 29). Data/account information or balance is stored in the memory of smart

token and account information/dollar amount is updated at the end of the play (col. 9 lines 46-52, and col. 10 lines 24-33). And sufficient motivation to combine is provided in the Office Action page 5.

Regarding argument (c), Argument is not persuasive. Applicant discloses in the specification, page 7 last line –page 8 lines 3, in three lines “If a smart card 10 is not accepted, the POS system can communicate with the smart card 10 regardless of the upper level user interface.” The office interpreted these three lines of disclosure as POS performs user smart card authentication and if the user smart card authentication is authentic the POS is/can be communicated to user smart card without any further authentication and/or upper level user interface. Doe discloses a computer system 102 authenticating smart card, and once smart card is authentic, creating marshalling buffer 306 to marshal the information required for transmission to the smart card (col. 11 lines 39-46) and the software development application 118 is immaterial, so long as the smart card proxy library is specified authentic within application (col. 11 lines 19-22).

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. Therefore, the examiner asserts that the system of the prior art, Doe, Kawan and Griswold teach or suggest the subject matter as recited in independent claims 1, 5, 10, and 16. Dependent claims are also rejected at least by virtue of their dependency on

independent claims and by other reason set forth in this office action dated 7/5/06.

Accordingly, rejections for claims 1-21 are respectfully maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant on page 7 last line-page 8 lines 2 discloses If a smart card 10 is accepted, the POS system can communicate with the smart card 10 regardless of the upper level user interface. And claims "...to control access and communication between the reading and writing device or terminal and the fixed data structure on the card regardless of the structure of an upper level user interface" as recited on claims 5, 10, and 16. It is unclear how access is controlled and communicated regardless of the upper level user interface. The Office interpreted this above limitation as POS terminal performing user smart card authentication and if the user smart card authentication is authentic, access is controlled and the POS is/can be communicated to user smart card without any further authentication and/or upper level user interface/API. If however Applicant has a different explanation as argued repeatedly, applicant needs to provide additional concise and clear disclosure.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kawan (U.S. Patent No. 6,289,324 B1).

As per claim 1, Kawan teaches a smart card having means for interfacing with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface, said means including a memory with a defined data file structure comprising:

at least one read only field (Kawan Col. 8 lines 33-38, Col. 10 lines 18-31, Fig. 2 No. 204);

at least one encrypted read/write field (Kawan Col. 4 lines 49-62); and

at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43).

8. Claims 16, 17, and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Deo et al. (Deo, Patent No.: US 6,547,150 B1).

Regarding claim 16, Deo discloses a transaction system including:

a smart card having a memory with a fixed data structure (col. 10 lines 49-col. 11 lines 68); and

at least one smart card reading and writing device or terminal (col. 3 lines 55-col. 4 lines 25, and col. 4 lines 41-67); and

wherein at least one of said smart card (fig. 1 element 104) and said reading and writing device or terminal (fig. 1 element 106 or 102) has application program interface that interfaces with middleware on at least one of said smart card and said reading and writing device or terminal (fig. 1 element 112 and 118; *APIs of smart card and application interface of computer/reader system*), said middleware interfacing between a user software application program and the reading and writing device or terminal to control access and communication between the reading and writing device or terminal and the fixed data structure on the card regardless of the structure of an upper level user interface (col. 9 lines 66-col. 10 lines 36, col. 11 lines 19-22 & 42-46, col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-67).

Regarding claim 17, Deo discloses a transaction system, wherein:

the middleware includes one or more of a DLL, an OCX, an APLET, or a library file (fig. 4 element 404).

Regarding claim 18, Deo discloses a transaction system, wherein:

an additional smart card authentication program contained on a separate card is resident on the smart card reading and writing device or terminal, said separate card having a different form factor such as SIM/SAM or a custom punch shape (col. 4 lines 41-55; *reader ... and many different smart cards ... from any smart card manufacturer*).

Regarding claim 19, Doe discloses a transaction wherein said application program interface resides on said card (fig. 1 element 112).

Regarding claim 20, Doe discloses a transaction wherein said application program interface resides on said reading and writing device or terminal (col. 12 lines 34-37).

Regarding claim 21 Doe discloses a transaction system as claimed in claim 16, wherein said middle ware resides on said reading and writing device or terminal, and separate middleware is on said smart card, said middleware on said reading and writing device or terminal calls said separate middleware on said smart card, that then communicates with the fixed data structure on the smart card (col. 10 lines 12-28).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2, and 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1).

As per claim 2, Kawan teaches all the subject matter as described above.

Kawan does not explicitly teach the read only field including at least one of a manufacturer identification field, a card identification field and a theater identification field,

However Griswold teaches a smart card, wherein the read only memory includes at Least one of a manufacturer identification field, a card identification field and a theater identification field (Griswold Col. 6 lines 53-65; ROM inside the smart card contains secure information, PINs),

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan because it would securely keep security information (Griswold Col. 6 lines 53-65). Therefore it is obvious to have at least one of a manufacturer identification field, a card identification field and a theater identification field included wherein the read only field because identification field would be secured.

As per claim 4, Kawan, and Griswold teach all the subject matter as described above. In addition Griswold teaches a smart card, wherein the non-encrypted read/write field includes at least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan because it would display user transaction information without comprising data integrity.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1), and in further view of Carlisle et al. (Carlisle, (U.S. Patent No. 5,649,118).

As per claim 3, Kawan and Griswold teach all the subject matter as described above. Kawan and Griswold do not explicitly teach a transaction log in the smart card.

However Carlisle teaches a smart card log file (Carlisle Col. 13 lines 55-67, col. 14 lines 26-35) that reads on a smart card, wherein the encrypted read/write field includes at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field,

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Carlisle with in the combination system of Kawan and Griswold because it would contain a message that comprises sequence number, date and time, and the identification information (Carlisle col. 14 lines 26-35). Therefore it is obvious to include at least one of a transaction log

field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field because it would give a clear information about the smart card transaction.

12. Claims 5-6, 10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1).

As per claim 5, Kawan teaches a transaction system (Kawan Col. 2 lines 21-27) including:

at least one smart card authorization device (Kawan Col. 4 lines 26-32, Fig. 2 No. 210, and col. 9 lines 27-43; **the ATM terminal is an authorization device that reads and authenticates/authorizes the data stored on the smart card**);
a communication interface (Kawan Col. 4 lines 26-32, Fig. 2 No. 208); and
a transaction verification server (Kawan Col. 3 lines 29-39);
Kawan discloses a software application program that interfaces the smart card data with card reader authenticator/ATM and financial institution host computer/banking institution for financial transaction. Kawan fails to explicitly teach data file structure/API/middleware, said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface.

However Deo discloses wherein the smart card authorization device includes means for interacting with a defined data file structure provided on a smart card (Deo col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-55; reader interacts with the API stored on the smart card), said defined data file structure on said smart card comprising a standardized fixed data structure that, with said means for interacting, can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface (col. 9 lines 66-col. 10 lines 36, col. 11 lines 19-22 & 42-46, col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3-25, and col. 4 lines 41-67).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of middleware/API within the system of Kawan because it is well known in the art. One would have been motivated to incorporate the teachings of middleware because it would communicate the card's content, files of the card, the reader and remote host.

As per claim 10, Kawan teaches a transaction system (Kawan Col. 3 lines 29-56) comprising:

at least one smart card including a memory with a defined data structure (Kawan Col. 3 lines 1-7, col. 10 lines 18-31), wherein said defined data file structure includes at least one read only field (Kawan Fig. 2 No. 204), at least one encrypted read/write field (Kawan Col. 4 lines 49-62, col. 9 lines 17-26), and at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43); and

read/write means for reading and writing data file to the memory of the smart card (Kawan Col. 4 lines 33-43, Fig. 2 No. 204, 206), wherein said read/write means includes an application program interface that interfaces between a user program and the defined data file structure utilizes a predefined set of commands to control the reading and writing of data to the memory card based on the defined data structure (Kawan Col. 3 lines 1-7, col. 10 lines 18-31).

Kawan discloses a software application program that interfaces the smart card data with card reader authenticator/ATM and financial institution host computer/banking institution for financial transaction. Kawan fails to explicitly teach data file structure/API/middleware, said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface.

However Deo discloses wherein the smart card authorization device interacts with a defined data file structure provided on a smart card (Deo col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-55; reader interacts with the API stored on the smart card), said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface (col. 4 lines 4-25; API enabling data to be exchanged between the card and reader and remote computer system).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of middleware/API within the

system of Kawan because it is well known in the art. One would have been motivated to incorporate the teachings of middleware because it would communicate the card's content, files of the card, the reader and remote host.

As per claim 6, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein said data file structure (Kawan Col. 10 lines 18-31) comprises:

at least one read only field (Kawan Col. 8 lines 33-38, Col. 10 lines 18-31, Fig. 2 No. 204);

at least one encrypted read/write field (Kawan Col. 4 lines 49-62); and

at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43).

As per claim 14, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein the read/write means further corn rises means for encrypting and decrypting data read from and written to said encrypted data field (Kawan Col. 10 lines 12-17).

As per claim 15, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein the predefined commands include a set of general commands, a set of read commands and a set of write commands (Kawan Col. 10 lines 18-31, col. 4 lines 33-43).

13. Claims 7, 9, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1) and further in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1).

As per claims 7 and 11 Kawan and Deo teach all the subject matter as described above. It is well known to store serial number identifier on the read only memory of a smart card. However Kawan and Deo do not explicitly teach serial number/SIM stored on read only memory of the smart card. Griswold teaches a transaction system, wherein the read only memory includes at Least one of a manufacturer identification field, a card identification field and a theater identification field (Griswold Col. 6 lines 53-65; ROM inside the smart card contains secure information, PINs).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to store identifier information on read only memory of the smart card. One would have been motivated to do so because it securely stores sensitive data, like the identity of the serial number that need not be changed/modified, on nonvolatile memory.

As per claim 9, Kawan, Doe, and Griswold teach all the subject matter as described above. In addition Griswold teaches a transaction system, wherein the non-encrypted read/write field includes at least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the combination system of Kawan and Doe because it would display user transaction information without comprising data integrity.

As per claim 13, Kawan, Deo, and Griswold teach all the subject matter as described above. In addition Griswold teaches a transaction system, wherein the non-encrypted read/write field includes at Least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan and Deo because it would display user transaction information without comprising data integrity.

14. Claims 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1), and further in view of Carlisle et al. (Carlisle, (U.S. Patent No. 5,649,118).

As per claims 8, and 12 Kawan, Deo, and Griswold, teach all the subject matter as described above. Kawan, Deo, and Griswold do not explicitly teach smart card log file.

Carlisle teaches a smart card log file (Carlisle Col. 13 lines 55-67, col. 14 lines 26-35) that reads on a transaction system, wherein the encrypted read/write field includes at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Carlisle with in the combination system of Kawan, Deo, and Griswold because it would contain a message that comprises sequence number, date and time, and the identification information (Carlisle col. 14 lines 26-35). Therefore it is obvious to include at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field because it would give a clear information about the smart card transaction.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eleni Shiferaw
7/5/06

Shiferaw
07/05/2006